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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/635,473	08/07/2003	Alejandro Wiechers	200207445-1	1048

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INTELLECTUAL PROPERTY ADMINISTRATION
FORT COLLINS, CO 80527-2400

EXAMINER

DANNEMAN, PAUL

ART UNIT	PAPER NUMBER
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3627

NOTIFICATION DATE	DELIVERY MODE
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11/28/2008

ELECTRONIC

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Notice of the Office communication was sent electronically on above-indicated "Notification Date" to the following e-mail address(es):

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Office Action Summary	Application No. 10/635,473	Applicant(s) WIECHERS, ALEJANDRO	
	Examiner PAUL DANNEMAN	Art Unit 3627	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 08 September 2008.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-8 and 18-23 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-8 and 18-23 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Continued Examination Under 37 CFR 1.114

1. A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on 8 September 2008 has been entered.

Status of the Claims

2. This action is in response to applicant's request for continued examination filed on 8 September 2008.
3. Claims 1 and 18 have been amended.
4. Claims 1-8 and 18-23 are pending and have been examined in this case.

Response to Arguments

5. Applicant argues that Lavery et al. merely discloses an on-line automated printing system that includes a front-end customer setup and product setup modules available on a web server. Applicant further argues that although a Print Ready File is produced embodying the product to be printed in Lavery et al., clearly, Lavery et al. do **not** disclose, teach or suggest features of Applicant's **newly amended** independent claims. Applicant further argues that namely, Lavery et al. is missing the Applicant's claimed automatically pre-flight the digital file at the designer location, including **automatically checking for common errors** associated during a prepress stage, automatically revising incorrect printing instructions and **automatically adding missing printing instructions** to the received document file. The Examiner respectfully must disagree. **Firstly**, Lavery in at least Fig.39 and Column 7, lines 1-67 and specifically in lines 1-12 discloses a client side application which provides an automated, consistent, error-free and rapid processing of files used in the printing process. Lavery in at least

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Column 7, lines 13-17 further discloses that proofing is automated and is done through a web site, where PostScript is automatically created, trapped, imposed, and color separated, All of which according to Applicant's specification paragraphs [0003-0006 and 0028] are errors (pre-press common errors). **Secondly**, regarding the ***"automatically adding missing printing instructions"*** as per applicant's specification paragraph [0003], are errors common to composition, imposition, color separation, etc. are steps which traditionally are performed by a "stripper," a knowledgeable person in the pre-press industry who manipulates film directly (Lavery, Column 6, lines 17-25) all of which Lavery solves as disclosed by at least Column 7, lines 13-17 where proofing is automated and is done through a web site, where PostScript is automatically created, trapped, imposed, and color separated. **Thirdly**, per applicant's specification Figure 1, paragraphs and paragraph [0034] the pre-flight checks are done automatically at step 106, however any automatic corrections (steps 108, 110, 112, 114 and 116) are as indicated in applicant's paragraph [0035] ***"set up remotely from the designer location."***

6. Applicant further argues that ***"Lavery et al. do not disclose or suggest the Applicant's real time configuration information regarding a print production device at the print service provider location."*** The Examiner respectfully disagrees. Lavery in at least Column 8, lines 22-34 discloses that the resulting features of the overall system includes the following: 1) the system contains all of the data the customer needs in order to print the customer's materials. Lavery in at least Column 11, lines 24-34 discloses a prepress application such as color washing is performed. Lavery in at least Column 21, lines 50-67 further discloses US patent application Ser. No. 09 /480,344 (US Patent 6,633,890), which is herein incorporated by reference, contains all the necessary information for printing a particular job (PRF). The print ready file (PRF) is automatically generated (US 6,633,890 Column 1 lines 39-46). Also in US 6,633,890, Column 2, lines 59-67 and Column 3, lines 1-3 discloses that the preflight checking of Lavery normalizes (washes) the information to produce an EPS file to remove problems and anomalies commonly shared in a known format like PostScript. Also, the Examiner notes that the limitation "real-time" does not appear in any claim.

Claim Rejections - 35 USC § 103

7. **Claims 1-4, 7 and 18-22** are rejected under 35 U.S.C. 103(a) as being unpatentable over Lavery et al., US 6,791,707 B2, hereafter known as Lavery and 09/480,344 (US 6,633,890 B1) incorporated by reference.

Claims 1 and 18:

With regard to the limitations:

- ***Creating a digital file at a designer location of an image to be printed.***
- ***Receiving printer configuration information.***
- ***Generating shipping instructions for the printed output.***
- ***Creating a file with the digital file and the shipping instructions.***
- ***Print and the ship the printed product.***

Lavery in at least FIG. 3 and Column 10, lines 15-67 discloses a series of steps used in creating a print order. A customer inputs data on the web site and the system creates a Print Ready File (PRF). The PRF is shown to the customer for proofing and once the order is approved the order is sent to the printer along with the customer's order data (i.e. quantity, shipping address, etc.). Lavery in at least Column 11, lines 1-13 further discloses that once the order is printed it is shipped to the customer. Therefore, it would have been obvious, at the time of the invention, to one of ordinary skill in the art that Lavery's customer can be the designer and subsequently creates the file which will be printed, based on the configuration and capability of the printer and provides the shipping instructions to the printer.

- ***Automatically pre-flighting the digital file at the designer location, automatically checking for common pre-press errors, automatically revising and adding missing printing instruction to the received document file;***

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- ***Automatically providing at the designer location a remote proofing function for a customer of the document file to be printed and automatically tracking the printing of the document file.***

Lavery in at least Fig.39 and Column 7, lines 1-67 and specifically in lines 1-12 discloses a client side application which provides an automated, consistent, error-free and rapid processing of files used in the printing process. Lavery in at least Column 7, lines 13-17 further discloses that proofing is automated and is done through a web site, where PostScript is automatically created, trapped, imposed, and color separated, All of which according to Applicant's specification paragraphs [0003-0006 and 0028] are errors (pre-press common errors). **Secondly**, regarding the ***"automatically adding missing printing instructions"*** as per applicant's specification paragraph [0003], are errors common to composition, imposition, color separation, etc. are steps which traditionally are performed by a "stripper," a knowledgeable person in the pre-press industry who manipulates film directly (Lavery, Column 6, lines 17-25) all of which Lavery solves as disclosed by at least Column 7, lines 13-17 where proofing is automated and is done through a web site, where PostScript is automatically created, trapped, imposed, and color separated.

Lavery in at least Column 12, lines 29-41 discloses a vendor order system (VOS) which processes tasks or information, including but not limited to, job instructions, purchase orders, invoices, payments, and shipping status of orders. The VOS includes a link to the ILLIAD in order to retrieve various customer related business information. Lavery in at least Column 13, lines 28-42 further discloses that the ILLIAD performs order processing and work-in-progress (WIP) functions.

Claims 2-4 and 19-21:

With regard to the limitations:

- ***Verify and correct the digital file.***
- ***Verify and correct the shipping instructions.***
- ***Supplementing the shipping instructions as required.***

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Lavery in at least Column 10, lines 58-67 discloses a customer viewing a file and either approving (or not), changing the digital print file, updating the customer data as required (i.e. quantity, shipping address, etc.). Therefore, it would have been obvious, at the time of the invention, to one of ordinary skill in the art that Lavery allows a customer to proof the print file and update or supplement the shipping instructions as required.

Claims 7 and 22:

With regard to the limitation:

- ***Updating job ticket in the file at the printer service location.***

Lavery in at least FIG.9 and Column 14 lines 44-46 discloses sending a message regarding the success or failure in the performance of a printing task. Lavery in at least Column 12, lines 29-67 discloses a Vendor Order System (VOS) which processes tasks or information, including but not limited to, job instructions, purchase orders, invoices payments and shipping status of orders. Therefore, it would have been obvious, at the time of the invention, to one of ordinary skill in the art that Lavery by messaging the success or failure of a printing task is updating the printer's job ticket.

8. **Claims 5-6, 8 and 23** are rejected under 35 U.S.C. 103(a) as being unpatentable over Lavery and US 6,633,890 B1 as applied to claims 1-2 and 18-19 above, and further in view of FedEx.

Claims 5, 6, 8 and 23:

With regard to the limitations:

- ***Sending to the print service provider the operational status of the shipping device.***
- ***Sending job status of the shipping device to the print service provider location.***
- ***Selecting a shipping device.***

Lavery in at least Column 11, lines 10-11 discloses that an order is shipped to a customer. Lavery in at least Column 12, lines 29-41 discloses a vendor order system (VOS) which

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processes tasks including job instructions, purchase orders, invoices, payments and shipping status of orders. Lavery in at least FIG.6 and Column 13, lines 43-53 further discloses the system database having billing and shipping rules. Lavery does not specifically disclose the operational status of the shipping device or selecting a shipping device. However, FedEx in at least FedExTrack discloses providing a package tracking service using email for notification and in FedEx Automated Solutions discloses a wealth of electronic tools, applications and APIs for customers to integrate into their processes to shorten response time, reduce inventory costs and simplify their shipping. Therefore, it would have been obvious, at the time of the invention, to one of ordinary skill in the art to combine the elements of Lavery's job and shipping status of orders with the well know FedEx Automated Solutions to achieve the predictable results of providing customers with a shipping solution that meets their needs.

Conclusion

9. Any inquiry concerning this communication or earlier communications from the examiner should be directed to PAUL DANNEMAN whose telephone number is (571)270-1863. The examiner can normally be reached on Mon.-Thurs. 6AM-5PM Fri. off.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Florian Zeender can be reached on 571-272-6790. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

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10. Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Paul Danneman/

Examiner, Art Unit 3627

19 November 2008

/F. Ryan Zeender/

Supervisory Patent Examiner, Art Unit 3627